Remarks

Claims 1 to 15 are pending. No claims have been canceled. No claims have been withdrawn from consideration. No claims are amended. No claims have been added.

Double Patenting Rejections

§ 101 Rejections

Claims 1-4 stand provisionally rejected under 35 USC § 101 as claiming the same invention as claims 1–4 of U.S. Pat. Application No. 10/807,007. The rejection is traversed.

Although both the instant claims and those of the reference are directed to telechelic polymers, the two differ in the nature of the end group. The reference is limited to ring-opened azlactone terminal groups and the instant claims are direct to azlactone terminal groups. Although the ring-opened azlactone groups may be prepared from the azlactones by reaction with a nucleophilic compound (as taught by Applicants), the two are distinctly different chemical moieties. The Examiner is invited to compare the two terminal groups as represented by the formulas in instant claim 5 and reference claim 5.

Withdrawal of the rejection of claims 1-4 under 35 USC § 101 in view of claims 1–4 of U.S. Pat. Application No. 10/807,007 is respectfully solicited.

Obviousness-type double patenting

Claims 11-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-21 of U.S. Pat. Application No. 10/807,007. The rejection is traversed.

The Examiner admits that the conflicting claims are not identical, but asserts that they are not patentably distinct from one another.

First, where the application at issue is filed on the same day as the patent in question, only a one-way determination of obviousness is needed in resolving the issue of double patenting. MPEP 804(II)(B)(1)(a). Obvious-type double patenting "requires rejection of an application

claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent." MPEP 804(II)(B)(1). The Patent Office must consider:

(A) The scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) The differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) The level of ordinary skill in the art; and

(D) The objective indicia of non-obviousness.

Such a rejection should make clear (1) the differences between the inventions defined by the conflicting claims; and (2) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. MPEP 804(II)(B)(1).

Importantly, "[w]hen considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, *the disclosure of the patent may not be used as prior art.*"

The Patent Office has completely ignored the differences between claims 11-13 of the present invention and the invention described in the claims of the reference. Thus, the applicants must presume that this rejection was in error. The Patent Office has failed to (1) identify the differences between claim 11-13 of the present invention and the invention described in the claims of the reference and further failed to (2) state the reasons why a person of ordinary skill in the art would conclude that the invention defined in claims 11-13 are obvious variations of the invention defined in a claim in the patent, as required by MPEP 804(II)(B)(1). The applicants submit that this rejection is improper and kindly request that it be withdrawn.

The Patent Office ignores, however, the requirement in the reference that the telechelic polymers have a ring-opened azlactone terminal group. The applicants submit that the presence of a ring-opened azlactone terminal group in the invention described in the reference makes these claims patentably distinct over those of the present application. There is no indication on the face of the claims in the reference, nor in the Examiner's rejection, to suggest why one of ordinary skill in the art, in possession of the claims of the reference (for one cannot refer to the specification of U.S. Pat. Application No. 10/807,007), would modify these claims to provide the

telechelic polymers of present claims 11-13, which do not include the requirement of a ring-opened azlactone terminal group.

The applicants therefore submit that the rejection of claims 11-13 under the judicially created doctrine of obviousness-type double patenting is improper and kindly request that it be withdrawn.

Furthermore, the MPEP at 804(II)(B) indicates that a "rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy *so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent.*" This policy, as indicated by the vintage of the case law cited in the MPEP, was particularly applicable when patents were granted for a term of 17 years from the date of issuance. Today, of course, patent term is defined by 35 U.S.C. § 154(a)(2), "such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed."

At page 1, lines 5-7 , 10/807,007 properly claims priority to U.S. Ser. No. 10/429,438, filed May 5, 2003, now U.S. Pat. No. 6,753,391. The present application, at page 1, lines 7–10, also properly claims ultimate priority to U.S. Ser. No. 10/429,487, filed May 5, 2003, now U.S. Pat. No. 6,762,257. Thus, the patent term of 10/807,007 and that of the present application would terminate on the same date (presuming no patent office delay justifying term extension). Therefore, the public policy directed against an "unjustified or improper timewise extension of the right to exclude granted by a patent" is not applicable in the present situation, where no such extension sought.

Accordingly, the Applicants kindly request that the obviousness-type double patenting rejection of claims 11-13 over 10/807,007 be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of claims 1-15 at an early date is solicited.

Respectfully submitted,

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